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Respectfully submitted,

By: *Thomas L. Evans*
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BANNER AND WITCOFF, LTD.

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Technology Center 2600

Atty. Docket No.
005156.00003

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Eric J HAYES ET AL.

Examiner: G. Cunningham

U.S. Pat. App. No.: 09/625,275

Group Art Unit: 2672

Filed: July 25, 2000

For: METHOD FOR EXAMINING FONT FILES FOR CORRUPTION

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450,
Alexandria, Virginia 22313-1450

Sir:

Applicants respectfully ask for reconsideration of both this application and the Office

Action dated June 8, 2004.

It is believed that no fees are due for the submission of this Request. If, however, the Commissioner deems that such fees are necessary, or that any other fees are required to maintain the pendency of this application under 37 C.F.R. §1.16 or §1.17, then the Commissioner is authorized to charge such fees to Deposit Account No. 19-0733.

In the Office Action, the Examiner rejected claims 1-4, 6-11 and 13 under 35 U.S.C. §103

over "MS-DOS Batch File Programming, 2nd Edition" (hereafter referred to as "the MS-DOS document"). (See the Office Action, page 2, lines 19-20.) The Examiner also rejected claims 1-4, 6-11 and 13 under 35 U.S.C. §103 over "the MS-DOS document" in view of U.S. Patent No. 5,963,641 to Crandall et al. (*Id.*, page 3, lines 1-3.) Upon reviewing the Examiner's comments supporting the rejections of the claims, however, Applicants note that these arguments do not present a basis for rejecting the claims over the MS-DOS document alone. Accordingly, Applicants only have addressed the rejection of claims 1-4, 6-11 and 13 over the combination of the MS-DOS document and the Crandall et al. patent.

Applicants respectfully traverse the rejection of claims 1-4, 6-11 and 13 over the MS-DOS document in view of the Crandall et al. patent, and courteously ask for its reconsideration. It is respectfully submitted that the combination of the MS-DOS document and the Crandall et al. patent would not teach or suggest the invention as recited in these claims.

Claim 1 recites receiving at a font server, information associated with a portion of a font file stored in a computer system. Applicants respectfully point out that neither the MS-DOS document nor the Crandall et al. patent teach or suggest the recited font server. The Examiner has suggested that the Crandall et al. patent discloses a font server at column 1, lines 28-35. Applicants respectfully point out that this portion of the Crandall et al. patent states:

This invention describes a device and method of examining electronically-recorded documents (typically in the form of one or more computer files) prior to printing, transmission or recording, and reporting and/or correcting all found inconsistencies and errors to assure compatibility with the printing press, recording apparatus, electronic file server or other output device.

Thus, the Crandall et al. patent does not actually teach or suggest a font server. Instead, the Examiner has improperly equated the generic teaching of a file server with a font server as specifically recited in claim 1.

In addition, claim 1 recites comparing, at the font server, information associated with the portion of the font file information associated with a portion of an uncorrupted font file and, in response to said step of comparing, determining, at the font server, whether the font file stored in the computer system is corrupted. Applicants respectfully point out that the Crandall et al. patent also does not teach or suggest determining whether a font file is corrupted. Instead, the Crandall et al. patent discloses a preflighting system for preflighting a source file to be printed or otherwise output. Thus, the Crandall et al. patent teaches checking for corrupted data in a file that refers to (or otherwise employs) one or more font files, not a font file itself. Further, the MS-DOS document does not, in any way, remedy this omission of the Crandall et al. patent.

With particular regard to claim 3, Applicants point out that this claim recites replacing the [corrupted] portion of the font file with the portion of the uncorrupted font file. Similarly, claim 4 recites transmitting the portion of the uncorrupted font file from the font server to the computer system, and storing the portion of the uncorrupted font file in memory in the computer system. In rejecting these claims, the Examiner relies upon the "copy" command disclosed in the MS-DOS document. Applicants respectfully point out that this command copies an entire file, and cannot be used to copy a portion of a file. Moreover, this command cannot be used to replace a portion of an existing file. Accordingly, Applicants respectfully submit that no combination of the "fc"

and “copy” commands relied upon by the Examiner would teach or suggest the features of the invention recited in either of claims 3 or 4. Applicants further submit that the Crandall et al. patent does not remedy these omissions of the MS-DOS document.

Regarding claims 2, 8-11, Applicants point out that these rejections rely heavily on the Examiner’s Official Notice. Applicants respectfully traverses this reliance on Office Notice, and *repeat* their request that the Examiner provide an affidavit of personal knowledge (to which Applicants are entitled under §104(d)(2)), or withdraw the rejections of these claims. For example, in reference to claim 2, the Examiner vaguely refers to “telecommunication software” and “xmodem,” “ymodem,” “zmodem,” and “procomm,” but the Examiner has provided no further information regarding this alleged software. With regard to claim 8, the Examiner has taken Official Notice of the use of well-known credit cards. Applicant disputes, however, that “the art” is replete with examples of the charging. There is simply no evidence that “the art” of using a MS-DOS file compare command includes examples of charging, as suggested by the Examiner. Moreover, the Examiner has provided no motivation or teaching in the art that would suggest combining charging a fee with checking a font file for corruption.

In view of the foregoing remarks, Applicant respectfully submits that the rejection of claims 1-4, 6-11 and 13 is improper. It is therefore requested that the rejection of these claims be withdrawn.

Lastly, the Examiner rejected claims 14 and 15 under 35 U.S.C. §103 over the MS-DOS document in view of the Crandall et al. patent, and in further view of U.S. Patent Application No.

2002/0120648 to Ball et al. Applicant respectfully traverses this rejection, and courteously asks for its reconsideration as well. In particular, Applicant respectfully submits that one of ordinary skill in the art would not have been led to combine the teachings of the Ball application with the MS-DOS document in the manner proposed by the Examiner. The portion of the Ball application relied upon by the Examiner relates to determining whether a CGI script generates an output. This portion of the Ball application has no relevance to the timing of an execution of a command on a file. Accordingly, Applicants respectfully submit that the combination of the MS-DOS document with the Ball application is improper, and that the “motivation” allegedly disclosed by Ball can only be based upon impermissible hindsight. It is therefore respectfully requested that the rejection of claims 14 and 15 be withdrawn.

With regard to the outstanding restriction requirement, Applicants again point out that, notwithstanding the Examiner’s recent conclusion that the stated claim groups require searches in different classes and subclasses, the Examiner has purportedly already examined the subject matter of all of the claims now pending in this application. Applicants therefore submit that the examination of these claims cannot constitute an undue burden, and therefore again ask that the restriction requirement be withdrawn in its entirety.

In view of the above amendments and remarks, Applicant respectfully submits that all of the claims are allowable, and that this application is therefore in condition for allowance.

U.S. Pat. App. No.: 09/625,275
Atty. Docket No.: 005156.00003

Favorable action in this regard is courteously requested at the Examiner's earliest convenience.

Respectfully submitted,

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September 8, 2004